



AF/362! IFW

Atty Docket No. 80398.P460

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:) Examiner: C. Hewitt, II
)
Hiroshi Ogino) Art Unit: 3621
)
Serial No. 09/966,540) Confirmation No: 4648
)
Filed: September 27, 2001)
)
For: ELECTRONIC GATHERING OF)
PRODUCT INFORMATION AND)
PURCHASING OF PRODUCTS)
_____)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

This is a reply to the Examiner's Answer mailed June 14, 2006 to the Appeal Brief filed March 6, 2006. Appellant is filing the present Reply Brief to respond the Examiner's arguments regarding the rejections of claims 7-13 and 15-17 under 35 U.S.C. § 112, second paragraph. On all other issues, Appellant maintains the arguments filed in Appeal Brief.

I. Claims 7-13 do comply with 35 U.S.C. § 112, second paragraph

The Examiner asserts that claim 7 is indefinite because claim 7 recites a "privacy system comprising a secure mechanism" but is directed to a transaction device that cannot comprise such a privacy system.

Appellant respectfully directs the Board's attention to the actual wording of claim

7:

An electronic transaction device comprising:

a sensor module configured to receive a product identification for a product through a product tag associated with the product;

a wireless module *configured to transmit through a privacy system*, the privacy system comprising a secure mechanism for correlating an identifier of the electronic transaction device with a user authorized to use the electronic transaction device; and

a communication module *configured to communicate* the transaction device identifier and the product identification *through* the wireless module and *the privacy system* to perform a transaction for the product without providing an identification of a user of the transaction device. [emphasis added]

When claim 7 is read as a whole, it is clear Appellant is not claiming the privacy system *as part of the electronic transaction device*. Instead, Applicant is claiming that the electronic device is configured to interact with a particular type of privacy system. Appellant respectfully submits that, instead of making claim 7 vague, Appellant's recitation of a particular type of privacy system in the body of the claim actually serves to more clearly define the boundaries of the claimed subject matter. Thus, claim 7 does satisfy 35 U.S.C. § 112, second paragraph, because one of skill in the art can determine the scope of the claim.

II. Claims 15-18 do comply with 35 U.S.C. § 112, second paragraph

The Examiner asserts that claim 15 is indefinite because it recites the limitation of “*the* transaction privacy clearing house” and there is no antecedent basis for the limitation. Appellant respectfully directs the Board's attention to claim 15 as it appears in Appendix A:

The method of claim 14, further comprising performing an electronic commerce transaction for the product with the product server through *a* transaction privacy clearinghouse using a device identifier for the transaction device, wherein the identity of the user is not known to the product server. [emphasis added]

Claim 15 as originally filed did claim “*the* transaction privacy clearing house.”

However, Appellant corrected the improper antecedent basis in the November 11, 2004 response to the first Office Action (mailed August 11, 2004). The November 11, 2004 response was received by the Office on November 16, 2004 as evidenced by the Application's image filer wrapper in PAIR. There is no evidence in the record that the Examiner refused to enter the November 11, 2004 amendment. In fact, in the final Office

Action (mailed February 24, 2005), the Examiner replied to arguments presented by Appellant in the November 11, 2004 response, including arguments that were directed to amendments to other claims. Accordingly, the November 11, 2004 amendment to claim 15 must be considered as having been entered by the Examiner. Therefore, the version of claim 15 that is the subject of the present Appeal does satisfy 35 U.S.C. § 112, second paragraph.

III. CONCLUSION

Because claims 7-13 and 15-17 do satisfy 35 U.S.C. § 112, second paragraph, Appellant respectfully requests the Board reverse the rejections of claims 7-13 and 15-17 under 35 U.S.C. § 112.

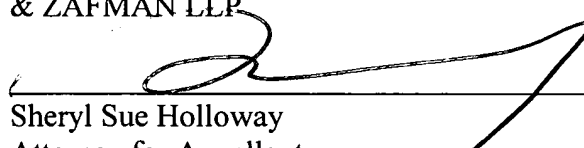
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: August 14, 2006



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**AMENDMENT TRANSMITTAL****PATENT**

Application No.: 09/966,540
Filing Date: 9/27/01
First Named Inventor Ogino
Examiner's Name: C. Hewitt, II.
Art Unit: 3621
Attorney Docket No.: 80398.P460

- ☐ An Amendment After Final Action (37 CFR 1.116) is attached and applicant(s) request expedited action.
- ☒ Charge any fee not covered by any check submitted to Deposit Account No. 02-2666.
- ☒ Applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 CFR 1.16 and 1.17, for any concurrent or future reply to Deposit Account No. 02-2666.
- ☐ Applicant(s) claim small entity status (37 CFR 1.27).

ATTACHMENTS

- ☐ Preliminary Amendment
- ☐ Amendment/Response with respect to Office Action
- ☐ Amendment/Response After Final Action (37 CFR 1.116) (reminder: consider filing a Notice of Appeal)
- ☐ Notice of Appeal
- ☐ RCE (Request for Continued Examination)
- ☐ Supplemental Declaration
- ☐ Terminal Disclaimer (reminder: if executed by an attorney, the attorney must be properly of record)
- ☐ Information Disclosure Statement (IDS)
- ☐ Copies of IDS citations
- ☐ Petition for Extension of Time
- ☐ Fee Transmittal Document (that includes a fee calculation based on the type and number of claims)
- ☐ Cross-Reference to Related Application(s)
- ☐ Certified Copy of Priority Document
- ☒ Other: Reply to the Examiner's Answer (3 pgs.)
- ☐ Other: _____
- ☐ Check(s)
- ☒ Postcard (Return Receipt)

SUBMITTED BY:

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

TYPED OR PRINTED NAME: Sheryl Sue HollowaySIGNATURE: REG. NO.: 37,850DATE: AUGUST 14, 2006ADDRESS: 12400 Wilshire Boulevard, Seventh FloorLos Angeles, California 90025TELEPHONE NO.: (408) 720-8300**CERTIFICATE OF MAILING BY FIRST CLASS MAIL (if applicable)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450 on August 14, 2006

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(10/14/03)